

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Dutta et al.	§	
	§	Group Art Unit: 3691
Serial No.: 09/833,347	§	
	§	Examiner: Kesack, Daniel
Filed: April 12, 2001	§	
	§	Confirmation No.: 3791
For: Method and Apparatus for	§	
Incorporating Scanned Checks Into	§	
Financial Applications	§	

35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Reinstatement of Appeal, filed in this case on July 17, 2008.

No fee is believed to be required for filing this Appeal Brief, as the appeal has been reinstated pursuant to MPEP 1204.01. No additional fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

This appeal has no related proceedings or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-50

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 13-15, 18, 31-33 and 46-48
2. Claims withdrawn from consideration but not canceled: 9-12, 17, 27-30 and 42-45
3. Claims pending: 1-8, 16, 19-26, 34-41, 49 and 50
4. Claims allowed: none
5. Claims rejected: 1-8, 16, 19-26, 34-41, 49 and 50
6. Claims objected to: none

C. CLAIMS ON APPEAL

The claims on appeal are: 1-8, 16, 19-26, 34-41, 49 and 50

STATUS OF AMENDMENTS

This appeal is a reinstated appeal being filed pursuant to MPEP 1204.01, and no amendments have been filed in response to the Final Office Action dated May 2, 2008. Amendments have been filed in response to the Office Action dated November 15, 2007, which re-opened prosecution of this case when it was under a previous appeal pursuant to an Appeal Brief filed by Appellants on June 18, 2007.

SUMMARY OF CLAIMED SUBJECT MATTER

Many financial applications and programs are present for users to perform financial planning and management. For example, Quicken is a financial planning program available from Intuit, Inc. Versions of such programs such as Pocket Quicken are available for mobile devices like the Palm handhelds available from Palm, Inc. Quicken and other programs allow for managing finances in areas, such as, for example, banking, investing, taxes, planning, loans, spending and saving. Many of these programs allow a user to pay bills on-line or to access information from a user's financial institution. A user may even access checks issued by a user along with an identification of which checks have cleared. These types of capabilities, however, do not reflect checks issued *to* a user. Presently, a user is required to enter check information into the financial program, deposit the checks, and reconcile deposits from financial statements received from the user's financial information. The features of the currently pending claims provide an improved method and apparatus for easier entry of information for checks issued to a user.

A. CLAIM 1 - INDEPENDENT

Claim 1 is directed to a method for processing a check (Specification page 16, lines 19-22). A check is received from a user at an automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400). The check is scanned to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404). The image is transmitted to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412). A transaction involving the check is performed at the financial institution data processing system to generate a transaction result (Specification page 8, lines 24-25 and page 26, lines 16-18; Figure 7, element 702). The transaction result is transmitted to the automatic teller machine (Specification page 15, lines 15-17). Both the image and the transaction result are transmitted by the automated teller machine to a mobile device associated with the user (Specification page 15, lines 17-19, page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

B. CLAIM 16 - INDEPENDENT

Claim 16 is directed to a data processing system. The data processing system includes a bus system, a communications unit connected to the bus system, a memory connected to the bus system, wherein the memory includes a set of instructions, and a processing unit connected to the bus system. The processing unit executes the set of instructions to (i) receive a check from a user at the automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400), (ii) scan the check to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404); transmit the image to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412), (iii) receive a transaction result involving the check from the financial institution data processing system (Specification page 15, lines 15-17), and (iv) transmit the image and the transaction result to a mobile device associated with the user (Specification page 15, lines 17-19, page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

C. CLAIM 19 - INDEPENDENT

Claim 19 is directed to a data processing system for processing a check (Specification page 16, lines 19-22). The data processing system includes receiving means for receiving a check from a user at an automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400). The data processing system also includes scanning means for scanning the check to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404). The data processing system also includes transmitting means for transmitting the image to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412). The data processing system also includes receiving means for receiving a transaction result involving the check from the financial institution data processing system (Specification page 15, lines 15-17). The data processing system also includes transmitting means for transmitting, by the automatic teller machine, both the image and the transaction result to a mobile device associated with the user (Specification page 15, lines 17-19,

page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

The equivalent structure for performing each of the receiving means, scanning means transmitting means for transmitting the image, receiving means and transmitting means for transmitting the image and the transaction result is data processing element 600 of Figure 6.

D. CLAIM 34 - INDEPENDENT

Claim 34 is directed to a computer program product in a computer readable medium for processing a check (Specification page 16, lines 19-22; page 28, line 20 – page 29, line 6). The computer program product includes first instructions for receiving a check from a user at an automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400). The computer program product also includes second instructions for scanning the check to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404). The computer program product also includes third instructions for transmitting the image to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412). The computer program product also includes fourth instructions for receiving a transaction result involving the check from the financial institution data processing system (Specification page 15, lines 15-17). The computer program product also includes fifth instructions for transmitting both the image and the transaction result by the automated teller machine to a mobile device associated with the user (Specification page 15, lines 17-19, page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to review on appeal are as follows:

A. GROUND OF REJECTION 1

Whether Claims 1, 5-8, 16, 19, 23-26, 34 and 38-41 were properly rejected as being obvious over Hyde, Jr. (U.S. Patent No. 6,038,553), hereinafter “Hyde”, in view of Cahill et al. (U.S. Patent No. 5,678,046), hereinafter “Cahill”, and further in view of Ozaki et al. (U.S. Patent No. 5,933,478), hereinafter “Ozaki”, under 35 U.S.C. § 103; and

B. GROUND OF REJECTION 2

Whether Claims 2-4, 20-22, 35-37, 49 and 50 were properly rejected as being obvious over Hyde, Cahill and Ozaki, as cited above, and further in view of “The XML Files”, under 35 U.S.C. § 103.

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1, 5-8, 16, 19, 23-26, 34 and 38-41)

Claims 1, 5-8, 16, 19, 23-26, 34 and 38-41 stand rejected under 35 U.S.C. § 103 as being obvious over Hyde, Jr. (U.S. Patent No. 6,038,553), hereinafter “Hyde”, in view of Cahill et al. (U.S. Patent No. 5,678,046), hereinafter “Cahill”, and further in view of Ozaki et al. (U.S. Patent No. 5,933,478), hereinafter “Ozaki”.

1. Claims 1, 7, 16, 19, 25, 26, 34, 38 and 40

With respect to Claim 1, such claim recites (i) transmitting the transaction result to the automatic teller machine and (ii) transmitting, by such automatic teller machine, the image and the transaction result to a mobile device associated with the user. The Examiner expressly acknowledges that Hyde does not teach or describe “transmitting the image of the checks, the image of the user, and the transaction result”. However, the Examiner further states that Cahill teaches that check images are faxed to a payee’s fax machine, and therefore it would have been obvious to modify the teachings of Hyde to include “sending the check cashing data captured according to Hyde from the ATM to the user’s fax machine because Cahill details the reasons it is desirable to archive electronic versions of checks” (emphasis added by Appellants). Appellants urge clear error in such rationale for making the Hyde/Cahill combination, as will now be described in detail.

As is commonly known to those of ordinary skill in the art, a user of an ATM machine does not carry around with them a fax machine to the ATM machine, as a fax machines requires a source of power and a telephone line for operation – items not typically found at an ATM machine – in addition to such a user fax machine being heavy, bulky and cumbersome to transport to an ATM. Stating it would have been obvious for a user to have a fax machine while a check is being provided by the user to such ATM¹ is an unnatural and unpredictable action that would therefore not have been obvious to one of ordinary skill in the art. Thus, a person of ordinary skill in the art would *not* have been motivated to modify the teachings of Hyde to include transmitting a fax in the Hyde ATM teachings, as such facsimile transmission would be

¹ Per Claim 1, the user is at the ATM machine because the ATM machine receives a check from the user.

without effect – as a user of the ATM would not have an ability to receive such a fax (as there is no power or phone connection) - and thus pointless.

Even assuming a user of the ATM did have a usable facsimile machine with them at the ATM, an ATM does not have an ability to initiate or send a fax. It is commonly known to those of ordinary skill in the art that such ATM devices do not have facsimile machines included therewith (also, see Hyde Figure 3 and col. 6, lines 15-32) – and thus there would be *no reason* to fax any type of information from the Hyde ATM as such ATM would have no ability to send the fax information. Thus, a person of ordinary skill in the art would *not* have been motivated to modify the teachings of Hyde to include an ATM transmitting a fax in the Hyde teachings, as such facsimile transmission would not be possible. As but one example, how would the image be input to the facsimile machine, as the ATM is un-attended. Thus, it is further shown that such combination is an unnatural combination with unpredictable results as there would be no control mechanism for inputting data to such a facsimile machine, and such facsimile machines are not traditionally found in or used by ATM machines.

In an alternative interpretation of the Examiner's reasons that were given in the rejection of Claim 1 – where the Examiner stated "sending the check cashing data captured according to Hyde **from the ATM to the user's fax machine** because Cahill details the reasons it is desirable to archive electronic versions of checks" would have been an obvious modification – if the Examiner instead intended that the user's fax machine was not with the user, but instead was located elsewhere such as in the user's home, this interpretation also results in an improbable and unpredictable operation, as in such a situation the user at the ATM would not be able to receive feedback such as check image and transaction result in a timely manner as the device which is alleged to be obvious (the user's fax machine) would not be accessible to the user during the ATM transaction. In addition, how would the ATM know where to send the fax to if the user's fax machine were distantly located under this interpretation? Thus, under either interpretation of what the Examiner meant in their "user's fax machine" being obvious, both interpretations result in an unnatural, improbable and unpredictable operation – strongly evidencing non-obviousness of Claim 1.

Applicants further urge that a person of ordinary skill in the art would not have been motivated to combine Hyde with Cahill as such references are non-analogous² – with one reference being directed to a cash dispensing machine, and the other directed to a facsimile machine. Such technologies are completely different and do not provide any synergistic results upon being combined, and thus a person of ordinary skill in the art would not have been motivated to make such an unnatural combination.

Further with respect to Claim 1, it is further urged that none of the cited references teach or suggest an ATM device that itself is used to transmit both a check image and the transaction results to a user's mobile device. In rejecting this aspect of Claim 1, the Examiner merely alleges that it would have been obvious to include receiving a fax image on a handheld device. Appellants urge that Claim 1 goes well beyond such assertion, as *both the check image as well as the transaction result* are transmitted to a mobile device. It is not seen how the resultant combination could transmit both types of information as a fax machine in an ATM – in addition to being an unnatural combination, as previously described – would have no access to the transaction result and thus would have no ability to send the transaction result, in addition to sending an image of the check, to a mobile device. For example, how would the fax machine scan this transaction result to get it into a proper format that the facsimile machine understands in order to be able to transmit it? Thus, in addition to Claim 1 having been erroneously rejected by an improper combination of references, it is further urged that Claim 1 has been erroneously rejected as a proper *prima facie* showing of obviousness has not been established by the Examiner.³

² The combination of elements from non analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness, *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

³ In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP 2143.03; *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

2. Claims 5, 6, 23, 24, 38 and 39

Appellants initially urge error in the rejection of Claims 5-6 for reasons given above with respect to Claim 1 (of which Claims 5-6 depend upon).

Further with respect to Claim 5 (and dependent Claim 6), it is urged that none of the cited references teach or suggest the claimed feature of “sending *an alert for the transaction to a plurality of users associated with an account*, the account being updated based upon the transaction result” (emphasis added). In rejecting Claim 5, the Examiner asserts that this missing claimed feature would have been obvious since it is old and well known that if the account has multiple names associated therewith, the statement will be sent to all accountholders. Appellants urge three-fold error in such assertion.

First, Claim 5 is not directed to sending a monthly statement to multiple users associated with an account, as is alleged to be old and well known, but instead is directed to sending *an alert for the transaction* itself to a plurality of users. Thus, the Examiner’s position as to what is old and well known fails to properly establish a prima facie showing of obviousness.

Second, whether something is old and well known is not a proper test for obviousness – and since this is a stated reason for rejecting Claim 5 such rejection is clearly erroneous. As stated by the Federal Circuit, “virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no

knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998). "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *See In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). Therefore, the Examiner's reliance on something being old and well-known is clearly erroneous.

Third, it is *not* old and well known that if an account has multiple names associated therewith, the statement will be sent to all accountholders. In fact, only a single statement is traditionally sent out by banks each month for a given account.⁴

Thus, it is further shown that Claim 5 (and dependent Claim 6) has been erroneously rejected, as (i) a proper prima facie showing of obviousness has not been established by the Examiner, (ii) the old and well-known assertion regarding obviousness is clear error, and (iii) it is not old and well known that if an account has multiple names associated therewith, the statement will be sent to all accountholders.

3. Claims 8, 26 and 41

Appellants initially urge error in the rejection of Claim 8 (and similarly for Claims 26 and 41) for reasons given above with respect to Claim 1 (of which Claim 8 ultimately depends upon).

Further with respect to Claim 8, such claim recites "sending the image of the user with the image of the check to the mobile device". Appellants urge that none of the cited references teach or suggest this claimed user-image-sending feature. In rejecting Claim 8, the Examiner states:

"Claims 7, 8, 35, 36, 40, 41, Hyde further teaches capturing an image of a user at an automated teller machine and stores the information along with both sides of the scanned check within the check cashing database."

⁴ Appellants' attorney them self has a bank account with multiple owners, and only a single statement is

It is urged that such assertion does not establish a teaching or suggestion in the cited references of the particular features recited in Claim 8 with respect to a user-image-sending feature. Further on, the Examiner states:

“It would be an obvious next step to include the user picture which is stored along with the check images *because of the security benefits* obtained by maintaining the user’s image” (emphasis added by Appellants).

Appellants urge numerous errors in such assertion, as follows.

First, this statement is pure subjective opinion by the Examiner, and not objective evidence, and therefore fails to meet up to the prima facie obviousness requirement expressly spelled out in the MPEP and extensive case law (as previously cited in footnote 2).

Second, the Examiner’s ‘reason’ for why it would be obvious is also faulty, as security benefits obtained by ‘maintaining’ a user’s image provides no motivation with respect to ‘transmitting’ a user’s image *to a mobile device*, as per the expressly recited features of Claim 8. The user has *already had their security checked* when the user’s image was transmitted to the transaction processing system (Hyde col. 8, lines 40-65). There is no additional security benefit that Hyde would accomplish by modifying such teachings to transmit a user’s image *to a mobile device*, as per the features of Claim 8. In contrast, these features of Claim 8 advantageously provide a way to track/account for which user of a multi-user account actually performed the transaction (Specification page 25, line – page 26, line 5) – it is not used for security screening purposes. Because none of the cited references teach or suggest such multi-user account, there would have been no reason to modify the teachings of the cited references to include such user image transmission to a mobile device, as is provided by the features of Claim 8.

Thus, it is therefore further urged that Claim 8 has been erroneously rejected due to this failure to properly establish a prima facie showing of obviousness with respect to such claim, and the Examiner has failed to establish valid reasons as to why a person of ordinary skill in the art would have been motivated to make such a modification as Hyde provides security in an

mailed out each month.

alternative fashion.

B. GROUND OF REJECTION 2 (Claims 2-4, 20-22, 35-37, 49 and 50)

Claims 2-4, 20-22, 35-37, 49 and 50 stand rejected under 35 U.S.C. § 103 as being obvious over Hyde, Cahill and Ozaki, as cited above, and further in view of “The XML Files”.

1. Claims 2-4, 20-22 and 35-37

Appellants initially show error in the rejection of these Claims 2-4, 20-22 and 35-37 for similar reasons to those given above with respect to Claim 1, as the newly cited “The XML Files” does not overcome the teaching/suggestion deficiencies identified hereinabove.

Further with respect to Claim 2 (and similarly for Claims 3, 4 20-22 and 35-37), such claim recites “importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program”. In rejecting Claim 2, the Examiner alleges that the cited “The XML Files” reference discloses receiving a bank statement in a format which is easily imported into bank reconciliation software at page 76, col. 2, paragraph 3. Appellants urge error in such assertion, as this cited paragraph makes *no* mention of any import of data into *bank reconciliation software*. Instead, this cited passage merely states that a file can be imported ‘to update your files’. A description of updating files does not teach any type of bank reconciliation software, as alleged by the Examiner. In fact, this cited article goes on to state that this imported information is used to print the information by the user (page 76, column 2, paragraph 4). Even assuming *arguendo* that the reference does teach such a financial reconciliation program, that still does not establish a teaching/suggestion of importing BOTH (i) the image AND (ii) the transaction result into a end-user financial program that is usable to manage finances of the user such that both a current account balance for the user AND the image of the received check are accessible to the user using such program. Thus, Claim 2 is further shown to have been erroneously rejected due to this additional failure by the Examiner to properly establish a *prima facie* showing of obviousness by their mischaracterization of the cited reference’s teachings.

Still further with respect to Claim 2, Applicants further show that a person of ordinary

skill in the art would not have been motivated to include the cited portions of “The XML Files” with the remaining aspects of the improbable and unnatural combination of references (as described above with respect to Claim 1), since there would be no ability to transmit XML files from an ATM device to a mobile device. Per the Examiner, the data is faxed to the mobile device from the ATM device. It is commonly known to those of ordinary skill in the art that a facsimile machine is not usable for transmitting such XMLO data files, but instead is used for transmitting *scanned images*. Thus, it is further urged that a person of ordinary skill in the art would not have been motivated to include the XML teachings from “The XML Files” reference as there would have been no way to facilitate transmitting of such file type by an ATM machine that faxes information to a user device. Thus, it is further shown that Claim 2 (and similarly for Claims 3, 4 20-22 and 35-37) has been erroneously rejected.

2. Claims 49 and 50

Further with respect to Claim 49 (and similarly for Claim 50), it is urged that none of the cited references teach or suggest the claimed feature of “transmitting the image *and* the financial information from the mobile device to the *another* data processing system”. As can be seen, per the features of Claim 49 in combination with Claim 4 (of which Claim 49 depends upon) a mobile device is effectively used as a relay such that *both* the check image *and* transaction result are transmitted to the mobile device, and this mobile device transmits *both* the check image *and* transaction device to another data processing system for processing by a financial program at the another data processing system. The cited combination of references doesn’t teach/suggest transmitting, *by a mobile device*, of *both* the transaction result *and* the image that was received by the mobile device. Thus, Claim 49 (and similarly for Claim 50) is further shown to have been erroneously rejected due to this additional failure by the Examiner to properly establish a *prima facie* showing of obviousness.

It is further shown that a person of ordinary skill in the art would not have been motivated to modify such resulting combination to include this missing claimed feature of a mobile device being used as, in effect, a relay device. The Ozaki handheld device, which is alleged by the Examiner as being equivalent to the claimed mobile device, is specially tailored to receive facsimile images. Because these are faxed images, and because the sender of the fax has an ability to send multiple copies of these fax images to multiple devices (col. 4, lines 37-43), the

more logical, and thus predicable, approach for sending the fax image to another data processing system would be for the originating host to directly send it to such another data processing system, since it has an ability to send multiple copies to multiple devices at the same time, thus efficiently reducing the required number of steps that are required to get the fax data to another data processing system. Thus, a person of ordinary skill in the art would not have been motivated to modify the Ozaki teachings to include the missing claimed features identified hereinabove, as such modification would be an illogical and inefficient technique when compared with other simpler approaches provided by Ozaki to achieve transmission to another data processing system. Thus, it is further shown that Claim 49 is not obvious in view of the cited references, as a person of ordinary skill in the art would not have been motivated to make such a change due to system complexities and inefficiencies. Thus, Claim 49 (and similarly for Claim 50) is further shown to have been erroneously rejected due to this additional failure by the Examiner to properly establish a prima facie showing of obviousness.

C. CONCLUSION

As shown above, the Examiner has failed to state valid rejections against any of the claims. Therefore, Appellants request that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellants request that the Board direct the examiner to allow the claims.

Date: September 15, 2008

Respectfully submitted,

/Wayne P. Bailey/

Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777

CLAIMS APPENDIX

The text of the claims involved in the appeal is as follows:

1. A method for processing a check, the method comprising:
receiving, from a user, a check at an automatic teller machine;
scanning the check to generate an image;
transmitting the image to a financial institution data processing system;
performing a transaction involving the check at the financial institution data processing system to generate a transaction result;
transmitting the transaction result to the automatic teller machine; and
transmitting, by the automated teller machine, the image and the transaction result to a mobile device associated with the user.
2. The method of claim 1 further comprising:
importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program.
3. The method of claim 2, wherein the financial program is located on the mobile device.

4. The method of claim 2, wherein the financial program is located on another data processing system other than the mobile device.
5. The method of claim 1 further comprising:
sending an alert for the transaction to a plurality of users associated with an account, the account being updated based upon the transaction result.
6. The method of claim 5, wherein the alert includes an identification of the transaction.
7. The method of claim 1 further comprising:
capturing an image of the user at the automatic teller machine.
8. The method of claim 7 further comprising:
sending the image of the user with the image of the check to the mobile device.
16. An automatic teller machine comprising:
a bus system;
a communications unit connected to the bus system;
a memory connected to the bus system, wherein the memory includes a set of instructions; and
a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive, from a user, a check at the automatic teller machine; scan the check to generate an image; transmit the image to a financial institution data processing system; receive

a transaction result involving the check from the financial institution data processing system; and transmit the image and the transaction result to a mobile device associated with the user.

19. A data processing system for processing a check, the data processing system comprising:
receiving means for receiving, from a user, a check at an automatic teller machine;
scanning means for scanning the check to generate an image;
transmitting means for transmitting the image to a financial institution data processing system;

receiving means for receiving a transaction result involving the check from the financial institution data processing system; and

transmitting means for transmitting, by the automated teller machine, the image and the transaction result to a mobile device associated with the user.

20. The data processing system of claim 19 further comprising:

importing means for importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program.

21. The data processing system of claim 20, wherein the financial program is located on the mobile device.

22. The data processing system of claim 20, wherein the financial program is located on another data processing system other than the mobile device.
23. The data processing system of claim 19 further comprising:
sending means for sending an alert for the transaction to a plurality of users associated with an account, the account being updated based upon the transaction result.
24. The data processing system of claim 23, wherein the alert includes an identification of the transaction.
25. The data processing system of claim 19 further comprising:
capturing means for capturing an image of the user at the automatic teller machine.
26. The data processing system of claim 25 further comprising:
sending means for sending the image of the user with the image of the check to the mobile device.
34. A computer program product in a computer readable medium for processing a check, the computer program product comprising:
first instructions for receiving, from a user, a check at an automatic teller machine;
second instructions for scanning the check to generate an image;
third instructions for transmitting the image to a financial institution data processing system;

fourth instructions for receiving a transaction result involving the check from the financial institution data processing system; and

fifth instructions for transmitting, by the automated teller machine, the image and the transaction result to a mobile device associated with the user.

35. The computer program product of claim 34 further comprising:

fifth instructions for importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program.

36. The computer program product of claim 35, wherein the financial program is located on the mobile device.

37. The computer program product of claim 35, wherein the financial program is located on another data processing system other than the mobile device.

38. The computer program product of claim 34 further comprising:

fifth instructions for sending an alert for the transaction to a plurality of users associated with an account, the account being updated based upon the transaction result.

39. The computer program product of claim 38, wherein the alert includes an identification of the transaction.

40. The computer program product of claim 34 further comprising:
fifth instructions for capturing an image of the user at the automatic teller machine.

41. The method of claim 40 further comprising:
sixth instructions for sending the image of the user with the image of the check to the mobile device.

49. The method of Claim 4, further comprising a step of transmitting the image and the financial information from the mobile device to the another data processing system.

50. The data processing system of Claim 22, further comprising means for transmitting the image and the financial information from the mobile device to the another data processing system.

EVIDENCE APPENDIX

This appeal brief presents no additional evidence.

RELATED PROCEEDINGS APPENDIX

This appeal has no related proceedings.